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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,281	07/10/2001	Michael Conor Minogue	660057-2000	8686
20999	7590	11/18/2003		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
			EXAMINER BOCKELMAN, MARK	
			ART UNIT 3762	PAPER NUMBER

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/902,281	Applicant(s) MINOGUE ET AL.	
	Examiner Mark W Bockelman	Art Unit 3762	<i>[Signature]</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 06 October 2003.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-64 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-45 and 52-64 is/are rejected.

7) ☒ Claim(s) 46-51 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-45 and 52-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtado USPN 6,341,237 in view of Axelgaard et al USPN 6,438,428.

Hurtado teaches several embodiments of an attachment means (20, 120 , 220) that serves as a belt member for holding electrodes to be placed upon the belt and user in positions for stimulating the same muscle groups and thus is concluded as covering the same "attachment means" as applicant. The examiner notes that applicant's whereby clause at the end of claim 1 is considered an intended use since none of the elements (i.e. electrodes or pulse generator) are positively recited in the claim. Although the Hurtado disclosure teaches the placement of his electrodes in similar places as applicant to exercise the umbilicus and obliques muscles, Hurtado is not considered to teach applicant's first and second locating means. Since applicant is entitled to those materials acts and structures disclosed in applicant's specification by virtue of the use of means plus function language, the Hurtado reference cannot be said to anticipate the markings 29, and 30a,b,c which are stated to be applicant's first and second locating means on page 20 lines 5-10 of the specification.

However, Axelgaard et al teaches a similar muscle stimulator with movable and removable electrodes that are positioned on an attachment member for fixing the electrodes at precise positions for stimulation. Since the electrodes are movable and removable to aid in such positioning/repositioning tasks, the attachment member is taught as being marked on the inside of the belt so as to provide reference marks as to the determined optimal positions to accommodate different size people. This allows new electrodes to be positioned as the older ones wear out or in instances when the attachment means is to be cleaned. The examiner considers these to be the same locating means as applicant describes in his specification. It would have been obvious at the time of applicant's US filing date to have provided the Hurtado attachment means with similar first and second locating means since Hurtado is also concerned with having adjustable electrodes to accommodate people of different girth. Such markings would provide reference marks when the electrodes are repositioned or replaced as the result of cleaning and or electrode replacement. Furthermore, Axelgaard et al teach a similar electrode attachment system as that taught by applicant is that a two sided conductive adhesive member serving as an electrode may be attached to a pulse bus delivery system. (see figure 4 of Axelgaard et al).

With respect to claims 2-11 applicant merely recites the specific placement of the locating means which are upon the same muscle groups as Hurtado. Hurtado also shows electrodes to be placed above and below the umbilicus.

In regard to claims 12-18, applicant recites a referencing means in the claims. As noted in applicant's specification beginning at page 21 lines 30+, the referencing means is considered to be the locating area 31 as well as the main locating means and electrode. Thus, in this regard, the central electrode(s) in Hurtado, their underlying areas as well as the markings as modified by Axelgaard serve as the reference means.

Concerning claim 19, the Hurtado device is a device designed to exercise the abdomen and help the user to tone and reduce. In this respect, it would have been obvious to those of ordinary skill in the art that progressive reduction in abdominal girth would require repositioning of the electrodes to stimulate the desired muscle groups and therefore as modified by Axelgaard et al, would entail placing additional marks for placement of the electrode.

In addressing claim 20, Hurtado shows in figure 9 that the belt maybe fashioned from a stretchable electrode material (note double arrows) including between the central contact electrode(s) (142-143) and the side contact electrodes (146, 148, 150 and 152) as well as their respective "locating means" as modified by Axelgaard. Although the reference does not discuss the relative stretchability of the various portions of the belt, the examiner considers it obvious that the hook and loop connecting portions to be of less stretchability since such is conventional for hook and loop coupling patches.

While the Hurtado reference does not possess the same "contact means" as recited in claims 21-45 and as disclosed as reference numerals 45 and 46 of applicant's figure 2, Axelgaard teaches repositionable electrodes that show applicant's arrangement of two sided electrode adhesive patches that are adhered to a round contact of the inner side of the belt. See figure 4 of Axelgaard et al as well as column 2 lines 20-29. To have modified the positionable electrode arrangement of the Hurtado device utilizing the arrangement of the Axelgaard et al electrode attachment system would have been an obvious alternative arrangement to accomplish the same task desired in the Hurtado patent.

In regards to claims 52-64, Hurtado teaches a belt with VELCRO securing means 30 and 130, and, as modified by Axelgaard, would include similar fastening means for fastening the electrode to the attachment means in that both Axelgaard and applicant

use adhesives to secure the electrodes to the attachment means. In addition, with respect to applicant's second embodiment in which applicant uses snap (stud fastener) connectors, Axelgaard shows that the attachment mean's fastening means may include the adhesive which binds to a stud connector as show in figure 1. With respect to claims 57-64, the examiner considers it to have been obvious to substitute male and female snap connectors for attaching the central electrode to the attachment means of Hurtado since such connectors are notoriously old and well known for attaching electrodes to various mounting devices.

Allowable Subject Matter

2. Claims 46-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not suggest or render obvious each of the means recited in the independent claim 1 and including the receiving means in dependent claims 46-51. The plastic snap fit receiving element 54 disclosed as applicant's receiving means including a jack for connecting a pulse generator electrically to the electrodes or an equivalent thereof is not disclosed or rendered obvious by the prior art.

Response to Arguments

Applicant's arguments filed 9-26-03 and 10-6-03 have been fully considered but they are not persuasive. Applicant has alleged that he has established priority to the claimed invention in filing official foreign parent application, however the examiner does

not find the invention being disclosed and claimed in this current application to be disclosed and supported in the foreign filed application

Specifically, applicant recites first and secondary locating means in the claims which are disclosed and claimed as markers along the attachment means (see elements 29 and 30a, the only such locating means in the 09/902,281 application being the three markers). The utilization of means plus function language imparts a limitation upon the claims to the corresponding structure disclosed and equivalents thereof. No such equivalent structure or means is found in the priority document S1999/0016 and thus the effective date of the invention does not antedate the references applied.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W Bockelman whose telephone number is (703)-308-2112. The examiner can normally be reached on Monday - Thursday 10-8:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.

MWB
November 13, 2003


MARK BOCKELMAN
RECEIVED